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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,306	11/02/2001	Aaron M. Smith	69597	4466

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EXAMINER

SON, LINH L D

ART UNIT PAPER NUMBER

2135

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,306

Applicant(s)

SMITH ET AL.

Examiner

Linh LD Son

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is written in responding to the application filed on 11/02/2001
2. Claims 1-23 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Wada et al, US Patent No. 5517618, hereinafter "Wada".

5. As per claims 20-21, Wada discloses "A system for seamlessly transferring a communication session between different devices on an IP network occurring between a correspondent and one of the devices, the system comprising: a first device having a first IP address that is used to directed packets intended for receipt by the first device from the correspondent over the network to the first device; a second device having a second IP address that is used to directed packets intended for receipt by the second device from the correspondent over the network to the second device" in (Col 11 lines 30-34, Col 11 line 60 to Col 12 line 20, and Col 15 line 65 to Col 16 line 16); "and a switch associated with the devices operable to enable the second device to receive at least certain ones of the packets intended for the first device from the correspondent for

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seamless session transfer between the device" in (Col 13 line 65 to Col 14 line 65).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5-9, 14-15, 17, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada et al, US Patent No. 5517618, hereinafter "Wada".

8. As per claims 1, 6-8, 9, 17, and 22-23, Wada discloses "A method of seamlessly transferring a communication session on an IP network from a first device to a second device, the method comprising: initiating a session between a correspondent device and a first device having a first device IP address" in (Col 11 lines 30-34, Col 11 line 60 to Col 12 line 20, and Col 15 line 65 to Col 16 line 16); "negotiating to transfer the session from the first device to a second device" in (Col 16 lines 25-55); "and transferring the first device IP address session from the first device to the second IP address session on another device so that data transferred from the correspondent device to the first device via the address thereof will be received by the second device" in (Col 13 line 65 to Col 14 line 65). However, Wada is silent on transfer the first device IP address to the second device. Nevertheless, Wada is silent on the process of migrating a the TCP

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session from the first network to the second network, which is obvious that the same IP address can not be used. Further, the transfer process is including transfer the TCP session to a temporary address and then transfer to the destination second address. Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to realize that the same IP address can be transferred from the first device to the second device only in the same network by utilize another temporary address until the first IP address gets re-ARP-ed to the second device in (Col 30 lines 23-45).

9. As per claim 5, Wada discloses "A method according to claim 1". However, Wada is silent on "the method further comprises: generating a wake-up message once the communication session is no longer to be transferred causing the first device to resume receiving communication sessions addressed to its IP address". Nevertheless, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to realize that the temporary communication session can also be done for only a period of time and then repeat the same communication session transferring process back to its origination (Col 30 lines 23-45).

10. As per claim 14, Wada discloses "A method according to claim 13, wherein the method further comprises: authenticating the notice from the first device to the Agent to ensure that the first device is the source of the notice" in (Col 33 lines 40-45).

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11. As per claim 15, Wada discloses "A method according to claim 13, wherein the method further comprises: notifying the Agent whether the second device is authorized to transfer the session" in (Col 33 lines 40-45).

12. Claims 2-4, 10-13, 16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada in view of Knight et al, US Patent No. 6377589B1, hereinafter "Knight".

13. As per claims 2-4, and 10-13, Wada discloses "A method according to claims 1 and 9, and further teaches a method of transfer the encrypted session and also authenticating the session" in (Col 33 lines 17-28). However, Wada is silent on "the created method for securely transferring the communication session comprises: generating a random number to serve as a session key for the secure transfer of the communication session between the first device and the second device". Nevertheless, Patel discloses the "Method for establishing session key agreement" invention which includes a method of communicating a secure and encrypted conversation using a random number as a session in (Col 7 lines 51-65). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Wada's invention to incorporate Patel's method to provide a secure transferring session.

14. As per claim 16, Wada discloses "A method according to claim 13, and further teaches a method of transfer the encrypted session and also authenticating the session" in (Col 33 lines 17-28). However, Wada is silent on "the method further comprises: generating a random number to serve as a session key for the secure transfer of the session between the Agent and the second device; encrypting the session key; transferring the encrypted session key between the first device and the second device and the first device and the Agent; and using the session key to securely transfer the communication session from the Agent to the second device". Nevertheless, Patel discloses the "Method for establishing session key agreement" invention which includes a method of communicating a secure and encrypted conversation using a random number as a session in (Col 7 lines 51-65). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Wada's invention to incorporate Patel's method to provide a secure transferring session.

15. As per claims 18, Wada discloses "A method of transferring a communication session between a Transferring Node and a Correspondent Node from the Transferring Node to a Target Node without disrupting the communication session, the method comprising: initializing a communication session between a Correspondent Node and a Transferring Node" in (Col 11 lines 30-34, Col 11 line 60 to Col 12 line 20, and Col 15 line 65 to Col 16 line 16); "negotiating a session transfer between the Transferring Node and a Target Node" in (Col 16 lines 25-55); and further providing authentication mechanism to authenticate the session and also capable of transfer encapsulated

session. The session transferring is best describing in (Col 16 lines 1-18), which involves other gateways. However, Wada is silent on “generating a random number to serve as a session key as a result of the negotiating; encrypting the session key via a security association between the Transferring Node and an Agent; transmitting the encrypted session key between the Transferring Node and the Target Node; notifying the Agent that the communication session is being transferred from the Transferring Node to the Target Node; authenticating the transfer notification by having the Agent verify that the Transferring Node sent the transfer notification; intercepting the session communications intended for the Transferring Node via the Agent; and tunneling the session communications intended for the Transferring Node to the Target Node via the Agent”. Nevertheless, Knight discloses the “Communication System” invention which includes a method of communicating securely and encrypted conversation using a random number as a session key in (Col 5 lines 1-10, and Col 8 lines 34-50). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Wada’s invention to incorporate Patel’s method to provide a secure session transferring method.

16. As per claim 19, Wada and Knight disclose “The method of claim 18, wherein the method comprises: determining whether the Transferring Node has permission to transfer the communication session; and disabling the Transferring Node's ability to transfer the communication session if the Transferring Node does not has permission to

transfer the session" in (Knight, Col 5 lines 1-10, and Wada, Col 33 lines 43-45)

Double Patenting

1. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-23 of the instant application No. 10002306, hereinafter '306, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10002880, hereinafter '880. Although the conflicting claims are not identical, they are not patentably distinct from each other because as follow:

5. The instant application '306:

Exemplary Claims 1 and 9 recite:

Claim 1 recites:

(1) A method of seamlessly transferring a communication session on an IP network from a first device to a second device, the method comprising:
(2) initiating a session between a correspondent device and a first device having a first device IP address;
(3) negotiating to transfer the session from the first device to a second device;
(4) and transferring the first device IP address away from the first device to another device so that data transferred from the correspondent device to the first device via the address thereof will be received by the second device

6. The copending application '880:

Exemplary Claims 1 and 9 recite:

- (1) A method of seamlessly transferring a communication session on an IP network, the method comprising:
- (2) initiating a communication session between a correspondent device and a first device using a session specific IP address as the first device IP address;
- (3) negotiating to transfer the communication session from the first device to a second device;
- (4) and transferring the first device IP address from the first device to the second device so that communication session data transferred from the correspondent device to the first device via the address thereof will be received by the second device.

7. As underlined above, the limitation (1) and (4) of both applications recite the exact language.

However, the limitations (2), and (3) in '306 recites the "session" and the limitations (2), and (3) in '880 recites the "communication session". It is clearly that the language in '306 is broader than in '880. Nonetheless, it would be obvious for one having ordinary skill to realize by syntax of the claim language that the session in '306 is actually a communication session also. Therefore, the claims 1-23 in '306 are clearly obvious over claims 1-27 in '880.

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8. Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. Id. at 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting. In re Berg, 140 F.3d 1428, 1431, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998). A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son
Patent Examiner



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ASSISTANT PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2135